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ART UNIT	PAPER NUMBER
2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.

09/544,356</td><td>Applicant(s)

TOTTY ET AL.</td></tr>
<tr><td>Examiner

Avi Gold</td><td>Art Unit

2157</td></tr>
</table>

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*07 May 2007*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,7,9,11-26,31,33,35-50,55,57 and 59-72* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,7,9,11-26,31,33,35-50,55,57 and 59-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This action is responsive to the RCE amendment filed on May 7, 2007. Claims 1, 11, 13, 14, 25, 35, 37, 38, 49, 59, and 61 were amended. Claims 4, 8, 10, 28, 32, 34, 52, 56, and 58 were cancelled. Claims 1, 2, 7, 9, 11-26, 31, 33, 35-50, 55, 57, and 59-72 are pending.

Response to Amendment

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.   Claims 1, 25, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The use of a second set of one or more other frames which can display unrequested content is not found in the specification. The specification does disclose multiple frames that are of one set that can include the unrequested content, however it does not disclose multiple sets.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 2, 5-7, 13, 16-19, 25, 26, 31, 37, 40-43, 49, 50, 55, 61, 62, and 65-67

are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al., U.S.

Patent No. 6,317,761, further in view of Shuster et al. U.S. Patent No. 6,687,746.

Landsman teaches the invention substantially as claimed including a technique

for implementing browser-initiated user-transparent advertising and for interstitially

displaying an advertisement through a web browser (see abstract).

As to claims 1, 25, and 49, Landsman teaches a method, computer readable

medium, and a computer system for allowing a porthole engine to deliver unrequested

content to users that access requested content through the porthole engine, comprising

the steps of:

receiving, from a browser executing on a client, an initial request for requested

content (col. 25, lines 46-63; Landsman discloses a user at a client browser requesting

a web page);

wherein said initial request is received at said porthole engine (col. 8, lines 1-40;

Landsman discloses a request routed to a proxy server);

wherein said client is connected to a network through said porthole engine (col. 8, lines 1-40; Landsman discloses a client PC connected to a proxy server);

wherein said requested content resides on an origin server located separate from said porthole engine on said network (col. 8, lines 1-40; Landsman discloses a proxy server directing a request to a web server); and

said porthole engine responding to said initial request by sending frame data to said client (col. 1, lines 26-35; Landsman discloses advertisements transparently downloaded to a client computer and then displayed by a browser; col. 31, lines 65-67; col. 32, lines 1-49, Landsman discloses a browser displaying advertisements in frames);

wherein the frame data causes said request content and said unrequested content to appear on a display screen on a client (col. 1, lines 26-35);

wherein said frame data defines a plurality of frames (col. 31, lines 65-67; col. 32, lines 1-49);

wherein said plurality of frames includes a first frame and one or more other frames (col. 31, lines 65-67; col. 32, lines 1-49, Landsman discloses a browser displaying content in frames);

wherein said frame data further specifies that said requested content is to be displayed in said first frame, and that said unrequested content is to be displayed in said one or more other frames (Landsman, col. 9, lines 53-63; col. 10, lines 61-65; col. 31, lines 65-67; col. 32, lines 1-49).

Landsman fails to teach the limitation further including the frame data causing the client to re-request said requested content.

However, Shuster teaches a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract). Shuster teaches a client requesting content again after receiving the frameset data (col. 9, lines 8-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Shuster where the frame data causes the client to re-request said requested content. One would be motivated to do so because it loads the frameset with data.

Regarding claims 2, 26, and 50, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein the request content includes a web page, and wherein the porthole engine causes the web page to be encapsulated within a paneled frame (col. 31, lines 65-67; col. 32, lines 1-49; Landsman discloses a browser displaying content in frames).

Regarding claims 7, 31, and 55, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said requested content appears on a first portion of a content display region of said browser (col. 9, lines 53-63; col. 10, lines 61-65; Landsman discloses a requested web page displayed to a user); and

said unrequested content appears on a second portion of said content display region of said browser (Landsman, col. 9, lines 53-63; col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 13, 37, and 61, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 35, and 49 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial request and with said second request (col. 20; lines 58-67; col. 21, lines 1-10; Landsman discloses an agent checking the URL of a request); and

the step of sending frame data is performed in response to determining that said initial request is not a request for an embedded item (Landsman, col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 16, 40, and 62, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 wherein:

said porthole engine determines that said initial request is not a request for an embedded item by using information contained in the URL associated with said initial request and with said second request (Landsman, col. 20; lines 58-67; col. 21, lines 1-10); and

said porthole engine sends data that causes said unrequested content to appear on a portion of said content display region of said browser in response to determining that said initial request is not a request for an embedded item (Landsman, col. 31, lines 65-67; col. 32, lines 1-49).

Regarding claims 17, 41, and 65, Landsman and Shuster teach the method, computer readable medium, and a computer system of claims 1, 25, and 49 further comprising the step of using information about a particular user to tailor the unrequested content to that particular user (Landsman, col. 21, lines 10-28).

Regarding claims 18, 42, and 66, Landsman and Shuster teach the method, computer readable medium, and a computer system of claim 17, 41, and 65 wherein the information about the particular user is selected from a group consisting of information available to owners of the porthole engine;

information about the requested content; and

a combination of the information available to the owners of the porthole engine and the information about the requested content (Landsman, col. 21, lines 10-28).

Regarding claims 19, 43, and 67, Landsman and Shuster teach the method, computer readable medium, and a computer system of claim 1, 25, and 49 further comprising the step of identifying the users to personalize the unrequested content (col. 21, lines 10-28; Landsman discloses advertisements specifically targeted to the user).

5.   Claims 9, 11, 12, 33, 35, 36, 57, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Eilbott et al., U.S. Patent No. 6,553,393

Landsman teaches the invention substantially as claimed including a technique

for implementing browser-initiated user-transparent advertising and for interstitially

displaying an advertisement through a web browser (see abstract). Shuster teaches the

invention substantially as claimed including a system apparatus and method for hosting

and assigning domain names on a wide area network (see abstract).

As to claims 9, 33, and 57, Landsman and Shuster teach the method, computer

readable medium, and a computer system of claims 1, 25, and 49 wherein said porthole

engine determines the format in which to display said requested content and said

unrequested content based on one or more factors including at least one of differences

in browsers, components of requested web pages, and versions of the browsers (col.

21, lines 10-28; Landsman discloses ad selection based on user specific info collected

from and associated with the user operating the browser).

Landsman and Shuster fail to teach the limitation further including the content

format chosen by the porthole engine.

However, Eilbott teaches managing references to embedded objects in a markup

language data stream (see abstract). Eilbott teaches the use of a proxy server to

choose and translate the format of a page (col. 5, lines 12-23).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Landsman and Shuster in view of Eilbott to use a porthole engine to

choose a content format. One would be motivated to do so because it avoids the

transfer of data to other servers, which would speed up the generation of data and be
more efficient.

As to claims 11, 35, and 59, Landsman and Shuster teach the method, computer
readable medium, and a computer system of claims 1, 25, and 49 further comprising the
steps of:

the porthole engine receiving a series of subsequent requests from the browser
in response to the browser decoding said frame data, said series of subsequent
requests including a second request for said requested content (col. 8, lines 41-67;
Landsman discloses downloading restarted after another request); and

the porthole engine responding to said second request for said requested content
by requesting said requested content from said origin server and delivering said
requested content to said browser (col. 19, lines 25-63; Landsman discloses an agent
server downloading contents from another server).

Landsman and Shuster fail to teach the limitation further including requests
received from a browser processed by a proxy server.

However, Eilbott teaches the use of the proxy server requesting a page from the
origin server and delivering it to the requesting browser (col. 4, lines 22-63).

It would have been obvious to one of ordinary skill in the art at the time of the
invention to modify Landsman and Shuster in view of Eilbott to use a proxy server to
process requests received from a browser. One would be motivated to do so because it

avoids the transfer of data to other servers, which would speed up the generation of

data and be more efficient.

Regarding claims 12, 36, and 60, Landsman and Shuster teach the method,

computer readable medium, and a computer system of claims 11, 35, and 59 wherein

said porthole engine determines that said second request for said requested content is

not an initial request for said requested content by using information contained in the

URL associated with said initial request and with said second request (col. 7, lines 66-

67; col. 8, lines 1-40; Landsman discloses the proxy server providing files from cache to

other client PCs if they request the same files).

6.   Claims 14, 15, 38, 39, 63, and 64 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Landsman and Shuster further in view of Ackermann, Jr. et al., U.S.

Patent No. 6.606,653.

Landsman teaches the invention substantially as claimed including a technique

for implementing browser-initiated user-transparent advertising and for interstitially

displaying an advertisement through a web browser (see abstract). Shuster teaches the

invention substantially as claimed including a system apparatus and method for hosting

and assigning domain names on a wide area network (see abstract).

As to claims 14, 15, 38, 39, 63, and 64, Landsman and Shuster teach the

method, computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Shuster fail to teach the limitation further including the changing a target attribute of a link in an embedded frame document to affect frame behavior.

However, Ackermann teaches the updating of embedded links or hotspots in source Web pages to reflect the new URLs of moved target Web Pages (see abstract). Ackermann teaches the use of a URL of a link being changed to point to a new URL (col. 5, lines 25-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman and Shuster in view of Ackermann to change a target attribute of a link. One would be motivated to do so because it would allow for the proper URL of the link to be shown.

7.   Claims 20, 44, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman and Shuster further in view of Underwood, U.S. Patent No. 6,704,873.

Landsman teaches the invention substantially as claimed including a technique for implementing browser-initiated user-transparent advertising and for interstitially displaying an advertisement through a web browser (see abstract). Shuster teaches the invention substantially as claimed including a system apparatus and method for hosting and assigning domain names on a wide area network (see abstract).

As to claims 20, 44, and 68, Landsman and Shuster teach the method of claims 19, 43, and 67.

Landsman and Shuster fail to teach the limitation further including the method of

Claim 19 wherein the step of identifying the users is performed by a method selected in

a group consisting of:

attaching cookies to web pages that are browsed by a particular user;

observing the radius authentication transactions and the resulting network

address assigned to the client;

tracking network addresses assigned to the users; and

authenticating the user.

However, Underwood teaches secure gateway interconnection in an e-

commerce based environment (see abstract). Underwood teaches the use of cookie

authentication (col. 140, lines 29-46; col. 141, lines 30-45), a RADIUS server performing

authentication and allowing traffic from the client (col. 287, lines 65-67; col. 288, lines 1-

28), tracking of an IP address (col. 10, lines 3-18), and authenticating the identity of a

user (col. 50, lines 34-43).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Landsman and Shuster in view of Underwood to attach cookies to

web pages that are browsed by a particular user, observing the radius authentication

transactions and the resulting network address assigned to the client, tracking network

addresses assigned to the users, and authenticating the user. One would be motivated

to do so because they are all efficient methods of identifying a user and personalizing

unrequested content for them.

8.   Claims 21-23, 45-47, and 69-71 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Landsman and Shuster further in view of Markus, U.S. Patent No.

6,499,042.

Landsman teaches the invention substantially as claimed including a technique

for implementing browser-initiated user-transparent advertising and for interstitially

displaying an advertisement through a web browser (see abstract). Shuster teaches the

invention substantially as claimed including a system apparatus and method for hosting

and assigning domain names on a wide area network (see abstract).

As to claims 21-23, 45-47, and 69-71, Landsman and Shuster teach the method,

computer readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Shuster fail to teach the limitation further including the

automatically filling in one or more fields on a requested web page by using a database

coupled to the porthole engine.

However, Markus teaches an improved process that allows an entity to

automatically release personal data to other entities connected via a computer network

(see abstract). Markus teaches the use of a selective proxy server for automatically

filling in an online form and a personal data storage component used to for the

information to fill the forms in with (col. 1, lines 40-57).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Landsman and Shuster in view of Markus to automatically fill in one

or more fields on a requested web page by using a database coupled to the porthole

engine. One would be motivated to do so because it would allow the user to fill in forms

without entering anything.

9.   Claims 24, 48, and 72 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Landsman and Shuster further in view of Shapiro et al., U.S. Patent

No. 5,991,810.

Landsman teaches the invention substantially as claimed including a technique

for implementing browser-initiated user-transparent advertising and for interstitially

displaying an advertisement through a web browser (see abstract). Shuster teaches the

invention substantially as claimed including a system apparatus and method for hosting

and assigning domain names on a wide area network (see abstract).

As to claims 24, 48, and 72, Landsman and Shuster teach the method, computer

readable medium, and a computer system of claims 1, 25, and 49.

Landsman and Shuster fail to teach the limitation further including the use of a

content filtering technology based on identities of the users.

However, Shapiro teaches user name authentication for gateway clients

accessing a proxy cache server (see abstract). Shapiro teaches the use of

automatically restricting access by unauthorized users to specified web information (col.

1, lines 56-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Landsman and Shuster in view of Shapiro to use a filter to allow only

authorized users access to particular web pages. One would be motivated to do so because it would allow a way to make certain web pages exclusive.

Response to Arguments

10.   Applicant's arguments with respect to claims 1, 2, 7, 9, 11-26, 31, 33, 35-50, 55, 57, and 59-72 have been considered but are moot in view of the new ground(s) of rejection.

11.   Applicant's arguments regarding the separate use of Ackermann and Markus in 103 rejections, filed May 7, 2007, have been fully considered but they are not persuasive.

12.   In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the argument to claims 14, 15, 38, 39, 63, and 64, the applicant argues that the combination of references that includes Markus does not disclose rewriting a link in an embedded frame document to affect frame behavior. The examiner respectfully disagrees, there is a URL of a link being changed to point to a new URL which would affect the frame's behavior.

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

    U.S. Pat. No. 5,854,897 to Radziewicz et al.

    U.S. Pat. No. 6,128,655 to Fields et al.

    U.S. Pat. No. 6,338,059 to Fields et al.

    U.S. Pat. No. 6,466,975 to Sterling.

    U.S. Pat. No. 6,128,651 to Cezar.

    U.S. Pat. No. 6,636,247 to Hamzy et al.

    Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Avi Gold whose telephone number is 571-272-4002.

The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for

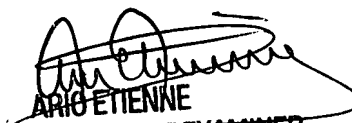the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

Patent Examiner

Art Unit 2157

AMG

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